REMARKS-General

1. The newly drafted independent claims 54 and 83 incorporate all structural limitations of the previously presented claims 54 and 83 and includes further limitations previously brought forth in the disclosure. No new matter has been included. All claims 54-72, 76, 79-86 and 88-91 are submitted to be of sufficient clarity and detail to enable a person of average skill in the art to make and use the instant invention, so as to be pursuant to 35 USC 112.

2. With regard to the rejection of record based on prior art, Applicant will advance arguments to illustrate the manner in which the invention defined by the newly introduced claims is patentably distinguishable from the prior art of record. Reconsideration of the present application is requested.

Regarding to the Rejections of Claims 54-72, 76-78 and 83-86 under 35USC102

3. The examiner rejected claims 54-72, 76-78 and 83-86 under 35USC102(e) as being anticipated by Goldenberg (US 2002/0065682 A1). Pursuant to 35 U.S.C. 102, "a person shall be entitled to a patent unless:

(e) the **invention** was described in (1) an application for patent, published under section 122(b), by **another** filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the Untied States only if the international application designated the United States and was published ender Article 21(2) of such treaty in the English language."

4. In view of 35 U.S.C. 102(e), it is apparent that a person shall **not** be entitled to a patent when his or her **invention was described** in an application patent which is published under section 122(b) by **another** filed in the United States before the invention by the applicant for patent.

5. However, the Goldenberg patent application and the instant invention are **not the same invention** according to the fact that the disclosure of Goldenberg patent

application does not read upon the instant invention and the newly amended independent claims 54 and 83 of the instant invention does not read upon Goldenberg patent application either.

6. The applicant respectfully clarifies the differences between the instant invention and Goldenberg for the purpose of overcoming the rejections under 35USC102(e) as follows:

(A) Regarding the newly amended independent claim 54, Goldenberg fails to anticipate a method of providing distance-treatment for registered users through Internet, which comprises the steps of (a) providing an information connection system comprising a computer, a visual signal producer and an audio signal producer, wherein the information connection system is arranged to be capable of communicating with a service provider through the Internet; (b) verifying and admitting the registered user to login the service provider through the Internet; (c) receiving a treatment request from the information connection system according to a diagnosis record of the registered user through the Internet; (d) based on the treatment request and a health information profile preset for the registered user in the service provider, selecting a treatment information data package from a treatment information database provided by the service provider; (e) sending digital treatment signals of the treatment information data package to the computer of the information connection system through the Internet to initiate a treatment operated by the information connection system on the registered user, wherein the treatment is selected from a group consisting of an audio and visual treatment to the registered user via the audio device and the monitor respectively; (f) feeding back a responsive health information of the registered user to the service provider for controlling and adjusting properties of the digital treatment signals of the treatment information data package to be sent from the service provider to the information connection system of the registered user; and (g) ***decoding the digital treatment signals into analog treatment signals*** which are sent to the computer to ***program and contro***l the treatment of the registered user when the treatment instrument is an ***analog type*** treatment instrument.

(B) Regarding the newly amended independent claim 54, Goldenberg fails to anticipate a system of providing distance-treatment for registered users through Internet, which comprises a service provider providing a treatment information database and a health information database, wherein the treatment information database includes

a plurality of treatment information with respect to different kinds of classified health problem and the health information database includes health information profiles established for the registered users respectively, wherein each of the health information profiles includes a personal general information and a personal health information for the respective registered user; an information connection system comprising a monitor and a computer adapted to be operated by the registered user; a network networking the information connection system with the service provider for data communication through the Internet, wherein the computer and the monitor are arranged to initialize a primary treatment for the registered user in an audio and visual format, wherein a treatment information data package sent from the service provider via the information connection system through the Internet to provide digital treatment signals to control the treatment, wherein the treatment information data package is selected from the treatment information database based on a treatment request sent from the information connection system to the service provider and the health information profile of the registered user in the service provider, wherein a responsive health information of the registered user is fed back to the service provider for controlling and adjusting properties of the digital treatment signals of the treatment information data package to be sent from the service provider to the information connection system of the registered user, wherein when a current health information of the registered user is detected during the biological treatment, the detected current health information is sent to the information connection system as the responsive health information such that the responsive health information is fed back to the service provider from the information connection system through the Internet, wherein the digital treatment signals of the treatment information data package is evaluated and sent to the information connection system of the registered user with respect to the received responsive health information, wherein the digital treatment signals of the treatment information data package is then adjusted to modified treatment information data package which contains updated digital treatment signals, wherein the modified treatment information data package is sent to the information connection system of the registered user through the Internet so as to transmit the updated digital treatment signals to the information connection system to update the primary treatment, Wherein the system further comprises a ***decoder*** connected between the information connection system and the treatment instrument which is an independent analog instrument, wherein the decoder ***converts the digital treatment signals*** received by the information connection system from the service provider to ***respective analog signals*** to control the treatment of the treatment instrument.

Response to Rejection of Claims 73-75, 79-80, 81-82, and 87-88 under 35USC103

7. The Examiner rejected claims 73-75, 79-80, 81-82 and 87-88 as being unpatentable over Goldenburg in view of Albert et al. (US 5,735,285) Pursuant to 35 U.S.C. 103:

"(a) A patent may not be obtained thought the invention is **not identically** disclosed or described as set forth in **section 102 of this title**, if the **differences** between the subject matter sought to be patented and the prior art are such that the **subject matter as a whole would have been obvious** at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made."

8. In view of 35 U.S.C. 103(a), it is apparent that to be qualified as a prior art under 35USC103(a), the prior art must be cited under 35USC102(a)~(g) but the disclosure of the prior art and the invention are not identical and there are one or more differences between the subject matter sought to be patented and the prior art. In addition, such differences between the subject matter sought to be patented **as a whole** and the prior art are obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains.

9. In other words, the differences between the subject matter sought to be patent as a whole of the instant invention and Goldenburg which is qualified as prior art of the instant invention under 35USC102(e) are obvious in view of Albert et al. at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains.

10. The applicant respectfully submits that the differences between the instant invention and Goldenberg are not obvious under 35USC103(a), due to the following reasons:

(C) Regarding the newly amended independent claim 54, the examiner is of the view that it would have been obvious to one having ordinary skill in the art to include decoding digital treatment signals into analog treatment signals as taught by Albert et al. into the teaching in Goldenberg so as to produce the instant invention. The applicant disagrees. The applicant respectfully submits that although Goldenberg discloses a

virtual doctor interactive cybernet system involving diagnostic features and treatment features, the instant invention is different from Goldenberg in that the method recited in the independent claim 54 requires the health information profile and a diagnosis record to be pre-obtained by the registered user whereas in Goldenberg, the relevant health information profile and the diagnosis record are also generated by the interactive network-based health information system. Thus, the instant invention concentrates on the treatment aspect with a pre-established diagnosis record while Goldenberg concentrates on diagnosis aspect of the health care process.

(D) The Examiner appears to reason that since Albert et al. teaches that decoding method generally, it would have been obvious to one skilled in the art to combine Albert et al. with the teaching of Goldenberg in order to produce the instant invention. But this is clearly **not** a proper basis for combining references in making out an obviousness rejection of the present claims. Rather, the invention must be considered as a whole and there must be something in the reference that suggests the combination or the modification. *See Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick*, 221 U.S.P.Q. 481, 488 (Fed. Cir. 1984) ("The claimed invention must be considered as a whole, and the question is whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination"), *In re Gordon*, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984), ("The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification.") *In re Laskowski*, 10 U.S.P.Q.2d 1397, 1398 (Fed. Cir. 1989), ("Although the Commissioner suggests that [the structure in the primary prior art reference] could readily be modified to form the [claimed] structure, "[t]he mere fact that the prior art could be modified would not have made the modification obvious unless the prior art suggested the desirability of the modification.") In the present case, there is no such suggestion. The instant invention concentrates on the treatment aspect of a health information system while Goldenberg concentrates on the diagnosis aspect thereof so that even combining Goldenberg with Albert et al. would not produce the instant invention as claimed.

(E) "The mere fact that a reference could be modified to produce the patented invention would not make the modification obvious unless it is suggested by the prior art." *Libbey-Owens-Ford v. BOC Group*, 4 USPQ 2d 1097, 1103 (DCNJ 1987).

While it is permissible to modify a reference's disclosure in the examination of patent applications, such modifications are not allowed if they are prompted by an applicant's disclosure, rather than by a reasoned analysis of the prior art and by suggestions provided therein. *In re Lesilie*, 192 USPQ 427 (CCPA 1977). In hindsight, the Examiner may feel that it would be obvious to combine Albert et al. with Goldenberg. Such hindsight reconstruction is not a permissible method of constructing a rejection under 35 U.S.C. 103. *In re Warner and Warner*, 154 USPQ 173, 178 (CCPA 1967).

Applicant believes that for all of the foregoing reasons, all of the claims are in condition for allowance and such action is respectfully requested.

The Cited but Non-Applied References

The cited but not relied upon references have been studied and are greatly appreciated, but are deemed to be less relevant than the relied upon references.

A fee in an amount of US$405.00 is submitted herewith to pay the fee for Request for Continued Examination (RCE). This amount is believed to be correct. However, the Commissioner is hereby authorized to charge any deficiency or credit any overpayment to Deposit Account No. 502111.

In view of the above, it is submitted that the claims are in condition for allowance. Reconsideration and withdrawal of the rejection are requested. Allowance of claims 54-72, 76, 79-86 and 88-91 at an early date is solicited.

Should the examiner believes that anything further is needed in order to place the application in condition for allowance, he is requested to contact the undersigned at the telephone number listed below.

Respectfully submitted,

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CERTIFICATE OF MAILING

I hereby certify that this corresponding is being deposited with the United States Postal Service by First Class Mail, with sufficient postage, in an envelope addressed to "Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" on the date below.

Date: 03/28/2008 Signature:

Person Signing: Judith Wong